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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,124	06/15/2006	Modechay Beyar	110/04969	6535
44909 PRTSI P.O. Box 16446 Arlington, VA 22215	7550 04/27/2010		EXAMINER PREBILIC, PAUL B	
			ART UNIT 3774	PAPER NUMBER
			MAIL DATE 04/27/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/561,124

**Applicant(s)**

BEYAR ET AL.

**Examiner**

Paul B. Prebille

**Art Unit**

3774

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-8, 10-21 and 23-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-8, 10-21 and 23-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 2/10/2010, 10/5/2010

***Election/Restrictions***

Applicant's election without traverse of Group I, species A, species X, and species VA in the reply filed on July 20, 2009 is acknowledged.

No currently pending claims are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention or species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 20, 2009.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-8, 10-13, 16-21, 23-26, 30-33, 36, 37, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuslich (US 5,059,193). Kuslich anticipates the claim language where axial member as claimed is the tie rod (16) of Kuslich, and the pliable tube as claimed is the body (12) of Kuslich that is clearly slotted along a majority of the length thereof; see Figures 1-21 and column 3, line 15 to column 4, line 57.

Regarding claim 18, the bag as claimed is the netting (200) of Kuslich.

Regarding claim 19, the bag or netting (200) can be biodegradable; see column 9, lines 47-51.

Regarding claim 32 and 33, the threads are the threads of the netting (200) material; see Figures 19 and 20.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-8, 10-21, and 23-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonutti (US 5,707,390) alone. Bonutti meets the claim language where the axial member as claimed is body (22) of Bonutti (see Figures 1 to 5 and column 4, lines 35-67) and the pliable tube as claimed is the sleeve (14) of Bonutti. However, Bonutti fails to clearly disclose that the tube is slotted along a majority of the tube length as now claimed. However, Bonutti teaches that two or more expanding portions (128) can be placed along the retractor depending upon the application; see column 7, lines 49-64. Therefore, it is the Examiner's position that it would have been clearly obvious to an ordinary artisan to put additional expanding portions such that a majority of the tube length is slotted where a particular application requires the same.

Regarding claim 6, the deforming of Bonutti can have a lock as claimed; see column 9, lines 26-40.

Regarding claim 13, the channel as claimed is the central passage (26) of Bonutti.

Regarding claim 15, the Applicant is directed to Figures 29 and 30 where the axial member is element (366) and the channel is element (360).

Regarding claim 18, the Applicant is directed to Figure 25 and column 12, lines 45-59 where a bag is utilized.

Regarding claim 19, the Applicant is directed to column 17, lines 23-35.

Regarding claims 20 and 32, the Applicant is directed to Figures 44 and 45 and column 15, lines 23-37.

Regarding claim 23, the Applicant is directed to Figures 6D, 6E and 6F where asymmetrical volumes are shown.

Regarding claims 27-29, Bonutti fails to disclose the transaxial force, applied force, or shore hardness as claimed. However, since the deformer of Bonutti can be used on joints (see Figures 17 and 18), the mere use/design with particular force and hardness values would have been considered *prima facie* obvious to an ordinary artisan in view of Bonutti alone that discloses a wide variety of materials (see column 17, lines 1-7) and uses (see the figures).

Regarding claim 30, the Applicant is directed to column 17, lines 1-7.

Regarding claim 33, the screw thread on body (22) is circumferential.

Regarding claim 34, the deforming can be inflated such that 100% of the volume is filled.

### ***Response to Arguments***

Applicant's arguments filed January 14, 2010 have been fully considered but they are not persuasive. In particular, the Applicant argues that Bonutti requires a large area

of contact such that it would not be obvious to have a majority of the tube slotted as claimed. However, the Examiner does not agree with this assessment of Bonutti because Bonutti does not say that the expanding portions should be limited single set. Rather, Bonutti discloses two sets of expanding portions and suggests that it would have been obvious to utilize more as needed; see column 7, lines 49-64. For this reason, the mere majority of the length, that is, more than 50% is considered clearly obvious over this teaching because Bonutti specifically suggests adding expander section was contemplated.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure

outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/  
Paul Prebilic  
Primary Examiner  
Art Unit 3774